<u>Remarks</u>

The Examiner's Answer mailed January 14, 2004 has been received and reviewed. Reconsideration of the claims is requested in view of the following reply the Examiner's Answer.

<u>Claim Rejections Under 35 U.S.C. § 102(b)</u>

With respect to representative claim 1, in maintaining the claim rejection, the examiner reasons that "the claims never utilize the computer executable instructions in any way. Thus, the type of data being stored on and transported via the label ... does not affect the claimed steps." *See* Examiner's Answer page 8, line 20 through page 9, line 1. The examiner cites no authority for this assertion. Applicant assumes that the examiner is referring to the Software Examination Guidelines promulgated by the U.S. Patent and Trademark Office, which state that "[l]anguage that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim element." *See* MPEP 2106(II)(C).

As can be seen, the reasoning set forth in the Examiner's Answer does not reflect the entirety of the Guidelines' admonition. According to the Guidelines, Applicant's utilization of computer executable instructions is only relevant if the claims *suggest* or make the recitation of executable instructions *optional*. In the present case, Applicant's recitation of executable instructions is neither suggested nor optional. Applicant's claim 1 recites "a computer readable medium, storing instructions executable by a computer of a purchaser of the product, coupled to the product by the label." The term "executable" is a term of art in

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computer science referring to one or more instructions for a processor. Claim 1 *does not* say that the computer readable medium *may* store executable instructions. Executable instructions are mandatory and cannot be passed over.

The "able" ending applied to the verb "execute" does not relegate the limitation to a mere suggestion or option. Under certain circumstances, select "able" words imply an option. For example, "a wheel securable to a frame" does not necessary mean that the wheel is secured to the frame, just that it can be. In the present case, it is true that selected devices in accordance with claim 1 may never be inserted into a purchaser's computer. However, that does not change the fact that all such devices store instructions executable by a purchaser's computer. There is no option, each device stores structures. These structures are instructions formatted, organized, named, etc. to be executed by a purchaser's computer. Such arrangements are "the essence of electronic structure." *See In Re Lowry*, 32 F.3d 1579 (Fed. Cir. 1994). When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium. *Id.*, at 1583. Thus, these structures are neither indefinite nor optional. As with any structure (*e.g.* screwdriver, engine, vehicle, etc.), whether the structural device is actually used is irrelevant. It is still a meaningful, defined, structural claim limitation.

Moreover, the examiner's response to Applicant's arguments illustrates the fundamental error under which the examiner has been proceeding in the present case. For example, "[t]he examiner notes that the claimed invention does not indicate that the computer executable instructions are downloaded to the purchasers's computer, only executed by it." *See* Examiner's Answer page 9, lines 6-7. Thus, according to the examiner, a purchaser's

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computer can execute instructions without loading them, making instructions equivalent to mere information. This is in direct contravention to MPEP 2106(IV)(B).

The MPEP delineates between executables and data. The first is patentable while the second is not. A claimed computer-readable medium encoded with a computer program (*e.g.* executable instructions) is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. *See* MPEP 2106(IV)(B)(a).

In contrast, certain types of descriptive material, such as music, literature, art, photographs and mere arrangements or compilations of facts or data, are merely stored so as to be read or outputted by a computer (such as taught by Dlugos) without creating any functional interrelationship, either as part of the stored data or as part of the computing processes performed by the computer; such descriptive material alone does not impart functionality either to the data as so structured, or to the computer. Such "descriptive material" is not a process, machine, manufacture or composition of matter. *See* MPEP 2106(IV)(B)(b).

Also, it is well known in the art that execution means *loading* the machine language code of the program into memory and *then performing* the instructions. *See Microsoft Press Computer Dictionary* 154 (2nd ed., Microsoft Press 1994). A computer cannot execute instructions without first loading them. The examiner's assertion to the contrary is completely without support. This misunderstanding has led to the improper use of "information" and "executable instructions" interchangeably in rejecting the claims, when the

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two are actually fundamentally different things. Information exchange does not anticipate passing executable instructions.

According to the Software Examination Guidelines, office personnel must rely on Applicant's disclosure to properly determine the meaning of terms used in the claims. *See* MPEP 2106(II)(C). With respect to the executable nature of the invention, Applicant states:

> "Software 140 provided on the CD-ROM tag 60 may include specific executables that are simply run from the CD-ROM tag 60. Alternatively, software 144 may actually be installed from a CD-ROM tag 60 into a memory device 14 that has non-volatile storage capability, such as a hard drive 16. ***Thus, during execution, the memory device 14 is typically the RAM 20 of the workstation 64, whereas installation and storage typically involves a hard drive 16 at a workstation 64.***" (Specification page 14, line 21 through page 15 line 4, emphasis added).

Applicant is clear that the memory device 14 in this instance is part of the purchaser's computer. *See* Specification page 6, lines 7-9 and page 14, 15-20. When executables are run from the tag 60, or installed from the tag 60, the executables are loaded into the memory 14 of the purchaser's computer. Thus, as presented hereinabove and in Applicant's Appeal Brief, Applicant's use of the terms "executable" and "instructions" fits squarely within the meaning such terms are given in the art.

Claim Rejections Under 35 U.S.C. § 103(a)

With respect to representative claim 3, as presented in Applicant's Appeal Brief and further explained hereinabove, Dlugos fails to teach or suggest all of the claim limitations.

In view of the foregoing, Appellant asserts that Dlugos neither anticipates nor renders obvious Appellant's claimed invention. Accordingly, Appellant respectfully requests that the rejections of claims 1-28 be withdrawn and that claims 1-28 be allowed.

DATED this _9th_ day of March, 2004.

Respectfully submitted,

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